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EXAMINER	
SANDERS, AARON J	

ART UNIT	PAPER NUMBER
2169	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,964	PONESSA, STEVEN J.	
	Examiner	Art Unit	
	Aaron J. Sanders	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *23 March 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the application filed on 23 March 2004.

Claims 1-36 have been examined and are pending in this application.

Specification

The abstract of the disclosure is objected to because the phrase "A method computer system" is grammatically incorrect. It appears that a comma should separate "method" and "computer".

The specification is objected to because "extensible" is spelled inconsistently. In some places it is spelled "Extensible" as in [0068], "Extensible Stylesheet Language", and in other places it is spelled "eXtensible" as in [0079], "eXtensible Stylesheet Language". There is no apparent difference in meaning between the spellings, but the specification should be consistent.

The use of the proprietary file extensions PDF and ZIP have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of proprietary information is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as proprietary information.

The Summary of the Invention is objected to because it is simply a recitation of the claims. This is not appropriate. See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in

the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

An amendment to the specification must not contain new matter. The amendment must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the amended specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Claim Objections

As per claims 2, 12, 22, and 31, the specific limitation clauses should be separated by semicolons as in claims 1, 11, and 21.

As per claim 12, the punctuation after the phrase, "The computer system of claim 11,:" is incorrect. To be consistent with the other claims it should be just the comma.

As per claim 31, the phrase, "comprising package list frame" is grammatically incorrect. It appears to need an article before "package".

Claim Rejections - 35 USC § 112 First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 20, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 10, 20, and 30 recite the limitation, "applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog". The specification does not appear to describe how the "information catalog" is generated using "additional technical metadata" when it has already been generated a first time.

Claim Rejections - 35 USC § 112 Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 20, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10, 20, and 30 recite the limitation, "applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog". However, the "information catalog" has already been generated in claims 1, 11, and 21.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-36 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. There also does not appear to be any tangible result of the data manipulation in the claims. Further, they are clearly not a combination of chemical compounds to be a composition of matter. Accordingly, the claims do not appear to contain a useful result. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

For example, in claims 1, 11, and 21, "accessing" and "applying" do not generate a tangible result. As per claim 31, simply disclosing a "graphical interface" does not require that there be any tangible output to the user. Specifically, just because the "graphical interface" is "adapted to being navigated" by a user does not require that it is navigated by a user. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138. Further, having "selectable" elements does not mean that they actually are selected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

> patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Myers Jr. et al., U.S. Pat. 6,959,268.

Only claims 1, 2, 5, 9, and 10 have been reproduced here as they are exemplary of the "computer system" of claims 11, 12, 15, 19, and 20 and the "computer program" of claims 21, 22, 25, 29, and 30.

As per claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29, and 30, Myers Jr. et al. teach:

1. A method for generating an information catalog relating to a business model, comprising the steps of:

accessing technical metadata from a data warehouse, said technical metadata being associated with data used by computer applications, said computer applications supporting business processes of the business model (See e.g. Fig. 4 where, see Brief Summary par. 20, "At the base of the CEE is an object oriented database managing an associative object model (product model) for providing a persistent understanding of product and program information, assets and tools available in the enterprise");

accessing business metadata from a first source outside of the data warehouse, said business metadata comprising relationships between the business processes and the computer applications, said business metadata further comprising relationships between the computer applications and the technical metadata (See e.g. Fig. 2 where, see Detailed Description par. 6, "The information transformation services layer 211 acts as a bidirectional link between the user

interface and the populated CEE database" and Fig. 4 where Tools 402 and 404 access "data" in "database 407");

accessing presentation metadata from a second source outside of the data warehouse, said second source being independent of the first source, said presentation metadata specifying a presentation format of the technical metadata and business metadata (See e.g. Detailed Description par. 3, "members interact with the CEE through familiar web interfaces and engineering tools with the presentation structured for the appropriate domain" and Fig. 6, "Client Side" layer 601); and

applying the presentation metadata to the technical metadata and the business metadata to generate the information catalog, said information catalog comprising the technical metadata and the business metadata in accordance with the presentation format specified by the presentation metadata (See e.g. Fig. 7 where, see Detailed Description par. 35, "the tabs 30 and buttons 31 at the top of the page represent a two-level hierarchical view of the information structure. The tabs 30 represent high level categories. Each tab has a set of buttons 31 or menus providing the next lower level breakdown. The "home" tab 32 contains some of the most basic information categories, such as the "process page" 33, as shown in the body frame").

2. The method of claim 1,

wherein prior to the applying step the method further comprises parsing the technical metadata and the business metadata to form a source tree such that the source tree comprises the parsed business metadata and parsed technical metadata logically linked to each other (See e.g. Fig. 8 where, see Detailed Description par. 66, "The product catalog 80 consists of all parts 81

that may be shared at the enterprise level. These parts may include both leaf-level parts 82, such as RAM memory chips, as well as complex assembly parts 83 and 84"),

wherein the applying step comprises traversing the source tree to form a result tree that includes the logically linked technical metadata and business metadata integrated with the presentation metadata (See e.g. Fig. 9 where, see Detailed Description par. 86, "suppose the product being designed is a display workstation. Since the product does not exist yet and is possibly unique to this project, the first part defined by the engineer would be a hardware (HW) part 41 characterizing that product. Suppose that a necessary component of this workstation is a processing unit. The engineer searches the product catalog for a processing unit that fits his requirements constraints. Searching can be accomplished through either a full text search of information describing the part or through exercise of a search engine managing collections of customized descriptive information"), and

wherein the method further comprises transforming the result tree into the information catalog such that the information catalog comprises files formatted in accordance with the presentation metadata (See e.g. Detailed Description par. 42, "This was facilitated by use of the Windchill™ tool's dynamic HTML generation mechanisms. When a user requests an HTML page via the browser, the hyperlink points to a template for the actual page that will be returned. The template contains Windchill™ tool "script" calls that get replaced with dynamically generated HTML").

5. The method of claim 1, wherein the information catalog comprises result files selected from the group consisting of Hypertext Markup Language (HTML) files, PDF files, ZIP files, and combinations thereof (See e.g. Detailed Description par. 42, "This was facilitated by use of

the Windchill™ tool's dynamic HTML generation mechanisms. When a user requests an HTML page via the browser, the hyperlink points to a template for the actual page that will be returned. The template contains Windchill™ tool "script" calls that get replaced with dynamically generated HTML").

9. The method of claim 1, wherein the data warehouse is a relational database management system, and wherein the technical data is stored in tables of the relational database management system (See e.g. Detailed Description par. 29, "The database tier 621 provides the persistence functionality using an Object Relational Database Management System (ORDBMS) 622 to store structured and unstructured data" and Fig. 6 which depicts tables within the ORDBMS).

10. The method of claim 1, said method further comprising:

accessing additional technical data from the first source (See e.g. Fig. 5 which depicts more than one program/user accessing data); and

applying the presentation metadata to the additional technical metadata and the business metadata to generate the information catalog (See e.g. Fig. 7 where, see Detailed Description par. 35, "the tabs 30 and buttons 31 at the top of the page represent a two-level hierarchical view of the information structure. The tabs 30 represent high level categories. Each tab has a set of buttons 31 or menus providing the next lower level breakdown. The "home" tab 32 contains some of the most basic information categories, such as the "process page" 33, as shown in the body frame").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 6-8, 13, 14, 16-18, 23, 24, 26-28, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers Jr. et al. as applied to claims 1, 2, 5, 9-11, 12, 15, 19, 20-22, 25, 29, and 30 above, in view of the *Microsoft Computer Dictionary Fifth Edition*, Microsoft Press, 2002, hereafter *Microsoft*.

As per claims 3, 13, and 23, Myers Jr. et al. disclose the subject matter of the claims upon which the instant claims depend, but do not appear to disclose traversing the source tree with a "recursive descent algorithm". However, *Microsoft* does make such a disclosure, see e.g. Recursion, "The ability of a routine to call itself". Myers Jr. et al. and *Microsoft* are analogous art because they both discuss electronic data manipulations. At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Myers Jr. et al. and *Microsoft* before him or her to traverse the source tree recursively. The motivation for combining these features is found in *Microsoft*, see e.g. Recursion, "Recursion enables certain algorithms to be implemented with small, simple routines".

As per claims 6, 16, and 26, Myers Jr. et al. disclose the subject matter of the claim upon which the instant claims depend, but do not appear to disclose storing the business metadata in XML files. However, *Microsoft* does make such a disclosure, see e.g. XML, "a condensed form of SGML". Myers Jr. et al. and *Microsoft* are analogous art because they both discuss electronic

data manipulations. At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Myers Jr. et al. and *Microsoft* before him or her to use XML. The motivation for combining these features is found in *Microsoft*, see e.g. XML, "XML lets Web developers and designers create customized tags that offer greater flexibility in organizing and presenting information than is possible with the older HTML document coding system".

As per claims 7, 17, and 27, Myers Jr. et al. disclose the subject matter of the claims upon which the instant claims depend, but do not appear to disclose including well-formed HTML within the XML files. However, *Microsoft* does make such a disclosure, see e.g. Well-formed, "An XML or HTML document that follows all the rules of syntax outlined in the protocol's specification". Myers Jr. et al. and *Microsoft* are analogous art because they both discuss electronic data manipulations. At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Myers Jr. et al. and *Microsoft* before him or her to use well-formed HTML within the XML files. The motivation for combining these features is found in *Microsoft*, see e.g. Well-formed, "A well-formed XML or HTML document can be read by all Web browsers without difficulty".

As per claims 8, 18, and 28, Myers Jr. et al. disclose the subject matter of the claim upon which the instant claims depend, but do not appear to disclose storing the presentation metadata in XSL files. However, *Microsoft* does make such a disclosure, see e.g. XSL, "A World Wide Web Consortium (W3C) standard stylesheet language for XML documents". Myers Jr. et al. and *Microsoft* are analogous art because they both discuss electronic data manipulations. At the time of the invention, it would have been obvious to one of ordinary skill in the art having the

teachings of Myers Jr. et al. and *Microsoft* before him or her to use XSL. The motivation for combining these features is found in *Microsoft*, see e.g. XSL, "XSL determines how data in an XML document is displayed on the Web. XSL controls what data will be displayed, in what format, and in what type size and style".

As per claims 4, 14, 24, and 31-36, Myers Jr. et al. disclose the subject matter of the claims upon which the instant claims depend, but do not appear to disclose displaying the catalog information in frames. However, *Microsoft* does make such a disclosure, see e.g. Frame, "A rectangular section of the page displayed by a Web browser that is a separate HTML document from the rest of the page. Web pages can have multiple frames, each of which is a separate document. Associated with each frame are the same capabilities as for an unframed Web page, including scrolling and linking to another frame or Web site". Myers Jr. et al. and *Microsoft* are analogous art because they both discuss displaying Web documents. At the time of the invention, it would have been obvious to one of ordinary skill in the art having the teachings of Myers Jr. et al. and *Microsoft* before him or her to display the catalog using frames. The motivation for combining these features is found in *Microsoft*, see e.g. Frames, "Frames... are often used as a table of contents for one or more HTML documents on a Web site".

The use of the term "adapted to" has been noted in the claims. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138.

31. A graphical interface of a computer system, comprising package list frame, an object list frame driven by the package list frame, and a detail frame driven by the object list frame,

said computer system comprising a processor and a computer readable memory unit coupled to the processor (See e.g. Myers Jr. et al. Detailed Description par. 20, "In a hardware context these elements could be simple parts such as memory chips or complex parts such as a microprocessor (which includes multiple simple parts), or assemblies such as a commercial server"),

said memory unit including an information catalog compiler that when executed by the processor implements a method for generating an information catalog relating to a business model (See e.g. Myers Jr. et al. Fig. 9),

said graphical interface adapted to being navigated by an end user of the method (See e.g. Myers Jr. et al. Fig. 7),

said method comprising generating the information catalog by applying presentation metadata to technical metadata and business metadata such that the information catalog comprises the technical metadata and the business metadata in accordance with a presentation format specified by the presentation metadata (See e.g. Myers Jr. et al. Fig. 7 where, see Detailed Description par. 35, "the tabs 30 and buttons 31 at the top of the page represent a two-level hierarchical view of the information structure. The tabs 30 represent high level categories. Each tab has a set of buttons 31 or menus providing the next lower level breakdown. The "home" tab 32 contains some of the most basic information categories, such as the "process page" 33, as shown in the body frame" where, see e.g. Myers Jr. et al. Fig. 2 where, see Detailed Description par. 6, "The information transformation services layer 211 acts as a bidirectional link between the user interface and the populated CEE database" and Myers Jr. et al. Fig. 4 where Tools 402 and 404 access "data" in "database 407"),

said technical metadata being associated with data used by computer applications supporting business processes of the business model (See e.g. Myers Jr. et al. Fig. 4 where, see Brief Summary par. 20, "At the base of the CEE is an object oriented database managing an associative object model (product model) for providing a persistent understanding of product and program information, assets and tools available in the enterprise"),

said package list frame including selectable applications of said computer applications and selectable associated table creators of tables relating to the technical metadata,

said object list frame being adapted to include selectable tables driven by a computer application and associated table creator selected from the package list frame,

said detail frame being adapted to include table information relating to a table selected from the object list frame.

32. The graphical interface of claim 31, wherein the detail frame is adapted to display an overview of the business model.

33. The graphical interface of claim 32, wherein the overview includes selectable processes of the business processes.

34. The graphical interface of claim 32, wherein the overview includes selectable applications of the computer applications.

35. The graphical interface of claim 31, wherein the package list frame, object list frame, and a detail frame are adapted to be generated by executing files of the information catalog.

36. The graphical interface of claim 35, wherein the files are selected from the group consisting of Hypertext Markup Language (HTML) files, PDF files, ZIP files, and combinations thereof (See e.g. Myers Jr. et al. Detailed Description par. 42, "This was facilitated by use of the

Windchill™ tool's dynamic HTML generation mechanisms. When a user requests an HTML page via the browser, the hyperlink points to a template for the actual page that will be returned. The template contains Windchill™ tool "script" calls that get replaced with dynamically generated HTML").

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Sanders whose telephone number is 571-270-1016. The examiner can normally be reached on M-Th 7:30a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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